Remarks

The conditional allowance of claims 12-22 and allowance of claims 34-46 is noted with appreciation. However, the applicant remains of the view that the prior art when properly combined in accordance with the caselaw does not teach or suggest the claimed invention to one of ordinary skill in the art.

The Examiner has challenged the applicant's assertion with respect to Nishimura on the basis of *In re Keller*. 208 USPQ 871. In the previous submission, the applicant did not rely (or at least intend to rely) on the proposition that in order to establish obviousness it is necessary to show that all the features of a secondary reference could be "bodily incorporated" into the structure of the primary reference. The applicant's assertion was based on the fact that "applicants cannot pick and choose among individual parts of assorted prior art references "as a mosaic to recreate a facsimile of the claimed invention and the "prior art must be read as a whole". *In re Fitch* 23 USPQ 2d 1780. In other words, in the context of the invention one has to enquire why Nishimura employed priorities and whether there is any suggestion that they would be applicable outside the context of his specific teaching. Moreover, the prior art must teach or suggest all the claim limitations (MPEP 2143).

In *In re Keller,* the primary reference taught a pacemaker with an RC timing circuit and the secondary reference taught a digital timing circuit as a substitute for an RC circuit in an analogous art. There was no reason to believe in that case, as far as the applicant is aware, that the digital timing circuit would only have application in the context of the secondary reference or that the teachings would in any way be incompatible. It was therefore held obvious merely to substitute the digital timing circuit of the secondary reference for the RC timing circuit of the primary reference. This is fairly standard reasoning.

The applicants are also aware that examiner's rely on *In re McLaughlin* to rebut applicant's objections that obviousness rejections are based on hindsight reasoning. *In re McLaughlin* was concerned with railcars. The primary reference showed the railcars and the secondary reference showed the side filler panels.

What the court actually said was that:

> Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper. The Cook patent does indicate that the car shown therein is suitable for carrying palletized loads with lift trucks being used for the loading and unloading, including stacking of the pallets. Since the secondary references show that it was well known to use side filler panels and bulkheads to confine palletized loads to prevent lateral and longitudinal shifting, we agree that those references would have suggested use of such panels and bulkheads with the Cook car for the same purpose."

Here again the primary reference showed the basic structure, and the secondary reference showed the missing structure in a similar environment. In the applicant's respectful submission, neither of these cases is analogous to the present situation. The Examiner agrees that hindsight reasoning must not include knowledge gleaned from the applicant's disclosure, and herein lies the disagreement with the Examiner. The applicants respectfully submit that one can only arrive at the information claimed by making use of knowledge gleaned only from the applicant's disclosure.

The Court further stated:

> "A patentable invention, within the ambit of 35 U.S.C. 103, *may* result even if the inventor *has*. in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use." In re Sponnoble, 56 CCPA 823, 405 F.2d 578, 160 USPQ 237 (1969)"

and then went on to find claim 15 patentable because it contained characteristics that solved the previously defined "space utilization problem".

All *In re McLaughlin* tells us in effect is that any later reconstruction is inherently hindsight in nature, but it does not detract from the basic rule that it is not permissible to pick and choose among various prior art teachings to show that one *could* have arrived at the invention to solve a particular problem known in the art. The relevant test is not what one could have done, but rather what one skilled in the art *would* have done, or what the prior art *would* actually have suggested.

In *Arkie Lures Inc. v. Gene Larew Tackle Inc.* (CA FC) 43 USPQ2d 1294, the court stated:

> The question is not whether salt "could be used," as the district court concluded, but whether it was obvious to do so in light of all the relevant factors. The beliefs of those in the field at the time, including beliefs that the plastisol lure would lose its surface qualities, texture, and strength, as well as the manufacturing uncertainties, are the position from which the decision maker must view the invention.
>
> It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements.

It appears to be mutually agreed that Hsing *per se* fails to teach the propagation of release messages in a priority sequence. The applicant pointed out that both references describe re-routing mechanisms. In the applicant's respectful submission the proper question to ask is what do the references suggest to one skilled in the art by way of combination. The applicant's position is that logically if one were to combine the references one would substitute the entire re-rerouting mechanism, not merely "pick and choose" a selected part of it in isolation. *In re Fitch*. The analogous situation in In *In re Keller* would have been a situation where the primary reference discloses one type of digital timing circuit, the secondary reference disclosed a difference type of timing circuit, and in order to arrive at the invention one needed to selectively extract only a portion of the timing circuit of the secondary reference. There is no suggestion in Nishimura that priority sequencing has application outside the context of his specific disclosure or that there would be any benefit in applying such sequencing to the teaching of Hsing outside of the context of Nishimura's re-routing mechanism.

The Examiner's new rejection is based on Arslan as allegedly rendering obvious the provision of the priority indicators and the propagation of release messages according to the priority of the connections. However, in order to find out what the prior art suggests as a combination, we still have to determine the purpose of the priority indicators in Arslan and determine whether such use would be suggested to one skilled in the art in the context of Hsing without relying on the applicant's teaching. The Examiner, quite properly aware that he must give a motivation founded in the prior art to combine the references, has suggested that such motivation would be to "have priority indicators for connections and propagate connection release messages according to the priority of the connections in the invention of Hsing in order to establish alternate paths first for higher priority connections after a network outage." However, in the applicant's respectful

submission, such an assertion goes beyond the actual teaching of the prior art and inherently relies in part on the applicant's teaching.

It is agreed that Arslan teaches the inclusion of "restoration priorities" in a CIRCUTI_STATE element that provides a description of a circuit (col. 5, lines 12-13). In accordance with the teachings of Arslan, "The restoration priority is an indicator specifying the level of priority that should be given to restoring a circuit, relative to other circuits" (col. 5, lines 23-24). Arslan does not teach sending release message in a sequence in accordance with the restoration priority. In Arslan, for each disrupted circuit, restoration manager sends takedown information "with the appropriate CIRCUIT_STATE element" to adjacent restoration processors. There is no teaching that this "takedown information" is sent in any particular order of priority, and indeed the CIRCUIT_STATE element state element includes within it the "restoration priority" (col 8. line 61), so it cannot be the case that the restoration priority is used to determine the order in which takedown information is transmitted for each disrupted circuit. This aspect of Arslan does not therefore provide a suggestion to propagate release messages as required by claim 1 wherein

> "said connection release messages are sent toward said source or destination entity in a sequence which corresponds to the priority hierarchy from the switched connection associated with the highest priority level to the connection associated with the lowest priority level."

Even the Examiner only asserts that "A message containing the connection's priority indicator and the source and destination of the connection is transmitted" (see page 4, lines 3-4 of the Office Action). The Examiner does not assert that connection release messages of Arslan are sent in an order corresponding to priority indicator.

If *arguendo* this teaching were somehow transferred to Hsing the result would be the sending of takedown messages containing priority information, but there is no teaching or suggestion that the takedown messages themselves should be sent in a sequence in accordance with the priority information contained within them.

The takedown message, which is not sent in any stated order, is received by an adjacent processor (col. 8, line 66) and the CIRCUIT_STATE element for that particular

circuit(col. 9 linc 5) is inserted at the bottom of the work list of the corresponding priority worklist of takedown function 221 (super high, high, medium, low or superlow). When the CIRCUIT_STATE element rises to the top of the worklist, disconnect manager develops a disconnect command and places this in a FIFO. This does not result in a connection release message being propagated from a network entity adjacent a failure (as required by the wording of claim 1) in a sequence dependent on the priority indicators.

An important claim limitation is that the connection release messages are propagated from the network entity having a signaling link which remains operational on one side therefore in a sequence which depends on the priority. In the applicant's respectful submission the prior art clearly fails to teach or suggest this limitation (MPEP 2143). Arslan teaches sending teardown messages containing restoration priority information; he does not teach sending teardown messages from the originating node in a sequence conforming to priority information, and such a step can only be arrived at by making use of information gleaned from the applicant's disclosure.

Arslan teaches sending disconnect commands (col. 9, line 18), but these are not sent from the originating network entity. They are sent from the entity receiving the teardown message and only after the CIRCUIT_STATE element has risen to the top of its work list, and the command has gone through the FIFO work list 247. This does not result in release messages being sent out in accordance with the limitations of claim 1. Arslan establishes a restoration priority associated with the circuits, but that is where the similarity with the present invention ends. Arslan does not teach sending out release message in a sequence based on the restoration priority from the originating node.

Simply put, in the applicant's respectful submission, a combination of Hsing and Arslan, when fairly interpreted, does not teach or suggest the limitations of claim 1, especially bearing in mind that the claim must be read as a whole (MPEP 2141.02). Even if *arguendo* one were to take the idea of associating restoration priorities indicators with the teachings of Hsing, without making use of information in the applicant's disclosure, one would not come up with the idea of sending connection release messages from the originating node in a sequence dependent on the restoration priority information because that limitation, in the applicant's submission, is simply not taught in Arslan.

In the applicant's respectful submission, similar arguments apply to independent claim 23, which is the apparatus counterpart of method claim 1, and claim 23 should be considered patentable for the same reason as claim 1.

It is believed that this application is in condition for allowance. Accordingly, reconsideration and allowance are respectfully requested.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION BY FACSIMILE (37 CFR 1.8)	Docket No. 14151-US

Applicant(s): John C. Burns et al.

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09/275,097	March 24, 1999	Kevin C. Harper	2666

Invention:

METHOD AND APPARATUS FOR PRIORITIZED RELEASE OF CONNECTIONS IN A COMMUNICATIONS NETWORK

I hereby certify that this response to the Office Action dated October 5, 2004
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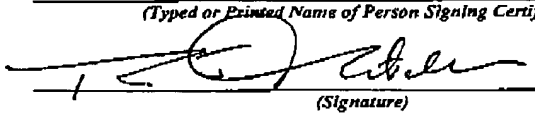

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